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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,047	12/15/2003	Jacob A. Flagle	8627/44	4057
7590	09/20/2007		EXAMINER	
J. Matthew Buchanan Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610			FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	
			MAIL DATE	DELIVERY MODE
			09/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,047	FLAGLE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan ML Foreman	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/2/07</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/07 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 5/2/07 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21 and 25 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,885,227 to Finlayson.

In regard to claims 21 and 25 – 28, Finlayson discloses an elongate member (Figure 2) comprising a proximal end, a main body having a first diameter, a distal end comprising an elongate tip (12d) having a uniform second diameter, and a taper portion (12c) disposed directly between the main body and distal end and defining a taper between the first and second diameters; a polymer coating (20) disposed on the distal end and commencing within a portion of the taper portion, at

least a portion of the exterior of the polymer coating has a second taper that approximates the taper of the taper portion (Figure 2), the polymer coating comprising a flexible tip having a length axially extending beyond the distal end, the length of the flexible tip being greater than a longitudinal length of the elongate tip; a radiopaque marker disposed in the flexible tip (Col. 3, lines 29 – 35) to provide localized weight within the flexible tip and spaced from the distal end of the elongate member; and a lubricious coating disposed on at least a portion of the main body (Col. 4, lines 19 – 27).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2004/0087876 to Eskuri in view of U.S. Patent No. 5,303,714 to Abele et al.

In regards to claims 1 – 28, Eskuri discloses an elongate member (Figure 1) having a proximal end (20), a main body having a first diameter, a distal end comprising an elongate tip (22) having a second uniform diameter, and a taper portion disposed directly between the main body and a distal end and defining a first taper between the first and second diameters [0017] [0018]; and a coating having at least a partial exterior [0022] – [0024] comprising a flexible tip having a length axially extending beyond the distal end, the ratio of the length to the first diameter being greater than 3:1 and between 12:1 and 250:1 [0018][0028][0029], the coating having a proximal portion and a distal portion, the proximal portion commencing within the taper portion of the elongate member (Figure 1). However, Eskuri fails to disclose a partial exterior of the coating having a second taper

that approximates the first taper of the taper portion. Abele et al. disclose a guidewire having a coating forming a flexible tip (24), wherein at least a portion of the partial exterior of the coating has a constant diameter or a second taper that approximates the first taper of a tapered portion (Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating as disclosed by Eskuri to include a second taper that approximates the first taper of a tapered portion as taught by Abele et al. in order to achieve a desired flexibility at the distal tip and to allow the elongate member to move freely throughout the vasculature of a patient (Col. 3, line 62 – Col. 4, line 26). The coating disclosed by Eskuri is a blend of polymers [0024]. Eskuri discloses the length of the flexible tip being greater than 3mm [0028][0029]. The length of the flexible tip extending beyond the distal tip is greater than the length of the distal tip [0020][0028][0029]. The elongate member is either stainless steel or nitinol [0016]. A lubricious coating is disposed on a portion of the main body [0030]. The flexible tip comprises radiopaque material [0026]. A solid marker is disposed in the flexible tip and a portion of the coating is disposed between the distal end of the elongate member [0026] and provides localized weight to the flexible tip. The flexible tip comprises a curvilinear distal portion [0023]. The flexible tip includes an opacifying agent [0026].

***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMLF



MAX HINDENBURG  
EXAMINER  
COMPUTER ART UNIT 3736  
PATENT AND TRADEMARK OFFICE